

CONFORMED

1 QUINN EMANUEL URQUHART & SULLIVAN LLP

Harold A. Barza (Bar No. 080888)

2 halbarza@quinnemanuel.com

Joseph M. Paunovich (Bar No. 228222)

3 joepaunovich@quinnemanuel.com

865 South Figueroa Street, 10th Floor

4 Los Angeles, California 90017-2543

Telephone: (213) 443-3000

5 Facsimile: (213) 443-3100

6 Attorneys for Plaintiff Moldex-Metric, Inc.

7
8 UNITED STATES DISTRICT COURT
9 CENTRAL DISTRICT OF CALIFORNIA
10 WESTERN DIVISION
11

12 MOLDEX-METRIC, INC., a California
13 corporation,

14 Plaintiff,

15 vs.

16 MCKEON PRODUCTS, INC., a
Michigan Corporation,

17 Defendant.
18
19
20
21
22
23
24
25
26
27
28

CASE NO. CV11-01742 GHK (AGR)

SECOND AMENDED COMPLAINT
FOR:

(1) FEDERAL TRADEMARK
INFRINGEMENT AND UNFAIR
COMPETITION

(2) FEDERAL TRADEMARK
DILUTION

(3) STATE TRADEMARK DILUTION

(4) COMMON LAW TRADEMARK
INFRINGEMENT AND UNFAIR
COMPETITION

(5) STATE UNFAIR COMPETITION

DEMAND FOR JURY TRIAL

FILED
2012 MAR 16 PM 3:45
CLERK U.S. DISTRICT COURT
CENTRAL DIST. OF CALIF.
LOS ANGELES

1 Plaintiff Moldex-Metric, Inc. ("MOLDEX"), by and through its undersigned
2 attorneys, for its Amended Complaint against defendant McKeon Products, Inc.
3 ("DEFENDANT") alleges as follows:

4 **I. THE PARTIES**

5 1. Plaintiff MOLDEX is a California corporation with a principal place of
6 business at 10111 West Jefferson Boulevard, Culver City, California 90232.

7 2. MOLDEX is informed and believes and thereon alleges that defendant
8 MCKEON is an Michigan corporation with a principal place of business at 25460
9 Guenther, Warren, MI 48091, and at all times relevant hereto was and is doing
10 business in the State of California sufficient to give rise to personal jurisdiction in
11 this forum.

12 **II. JURISDICTION AND VENUE**

13 3. This Court has subject matter jurisdiction over this action under 28
14 U.S.C. § 1331 (federal question jurisdiction); 28 U.S.C. § 1332 (diversity
15 jurisdiction); 28 U.S.C. § 1338(a) and (b) because this action arises under the
16 Lanham Act (15 U.S.C. §§ 1051 – 1127); and 28 U.S.C. § 1367 (supplemental
17 jurisdiction).

18 4. On information and belief, this Court has personal jurisdiction over
19 DEFENDANT because it conducts business within the State of California and has
20 committed the acts of trademark and trade dress infringement and federal and state
21 unfair competition that have given rise to this action in this district. DEFENDANT
22 has established minimum contacts with the forum such that the exercise of
23 jurisdiction over them would not offend traditional notions of fair play and
24 substantial justice.

25 5. Venue is proper in this district pursuant to 28 U.S.C. § 1391(b)
26 because, on information and belief, Defendant conducts business within this judicial
27 district and/or a substantial part of the events giving rise to the alleged claims in this
28 action occurred in this judicial district.

1 **III. FACTS COMMON TO ALL CLAIMS FOR RELIEF**

2 6. Since 1982, MOLDEX has been engaged in the business of
3 manufacturing and selling earplugs. Today, MOLDEX is one of the premier sellers
4 of foam earplug products throughout the world. The very first foam earplug
5 MOLDEX began selling in 1982 was bright green in color. For more than 28 years,
6 MOLDEX has continuously used a bright green color ("the Green Color Mark") to
7 identify its earplugs and to distinguish its earplug products from those made and
8 sold by others. Today, MOLDEX sells disposable earplugs bearing the Green Color
9 Mark under the name "Pura-Fit®."

10 7. MOLDEX's earplug products have a strong reputation in the industry
11 for being of extremely high quality.

12 8. To create further public awareness of MOLDEX's Green Color Mark,
13 MOLDEX has expended substantial time, effort and money advertising and
14 promoting the Green Color Mark in conjunction with its Pura-Fit® disposable
15 earplug and other earplug products which incorporate the Green Color Mark, both
16 throughout the United States and around the world.

17 9. As a result of MOLDEX's promotional and marketing efforts, the
18 Green Color Mark has become widely known and extremely valuable goodwill has
19 developed in it. By virtue of this promotion and marketing, and the substantial sales
20 of the Pura-Fit® earplug and other earplug products bearing the Green Color Mark,
21 the Green Color Mark has become distinctive of MOLDEX's ear plug products and
22 is identified with MOLDEX's goodwill and reputation.

23 10. MOLDEX is informed and believes and thereon alleges that
24 DEFENDANT has for many years been in the business of manufacturing and selling
25 personal hearing protection products.

26 11. MOLDEX is further recently informed and believes and thereon alleges
27 that DEFENDANT recently introduced and began selling bright green disposable
28 earplugs under the name "Snore BLOCKERS Soft Foam Earplugs" and "Shooters

1 Corded Foam Earplugs” (the “Accused Earplug Products”) throughout the United
 2 States that are intended to compete with MOLDEX’s Pura-Fit® earplug and other
 3 earplug products bearing the Green Color Mark.

4 12. MOLDEX is informed and believes and thereon alleges that
 5 DEFENDANT targeted MOLDEX’s disposable and reusable earplug product line
 6 because it knows that MOLDEX’s earplugs have a strong reputation in the industry
 7 for being of extremely high quality and that DEFENDANT chose to use a mark and
 8 trade dress confusingly similar to MOLDEX’s earplugs with which they are now
 9 competing in order to trade on MOLDEX’s goodwill by confusing the marketplace
 10 into believing that their hearing protection line is manufactured by, affiliated with or
 11 sponsored by MOLDEX.

12 13. On information and belief, DEFENDANT promotes, markets and
 13 distributes its hearing protection line, including the Accused Earplug Products, in
 14 the same marketing channels as MOLDEX.

15 14. DEFENDANT’s promotion, importation, marketing and sale of the
 16 Accused Earplug Products is causing and will continue causing irreparable harm to
 17 MOLDEX’s reputation and goodwill and to the value of MOLDEX’s Green Color
 18 Mark unless DEFENDANT’s conduct is enjoined.

19 **FIRST CLAIM FOR RELIEF**

20 **(Federal Trademark Infringement and Unfair Competition)**

21 15. MOLDEX realleges and incorporates herein by reference paragraphs 1
 22 through 14 of this Complaint.

23 16. DEFENDANT makes, imports, distributes, uses, offers to sell and/or
 24 sells in the United States, including this district, bright green earplugs that directly
 25 infringe MOLDEX’s Green Color Mark in violation of § 43(a) of the Lanham Act,
 26 15 U.S.C. § 1125(a) and Federal Unfair Competition laws.

27 17. MOLDEX has actively marketed, promoted, and continuously sold
 28 earplugs with the Green Color Mark for more than 28 years such that it has become

1 distinctive of MOLDEX's goods. DEFENDANT has used MOLDEX's Green Color
2 Mark without its authorization and continues to trade off the goodwill and reputation
3 created and maintained by MOLDEX in the Green Color Mark.

4 18. DEFENDANT's contemporaneous use of a bright green color mark
5 and trade dress for its earplugs will inevitably lead, if it has not already done so, to
6 confusion and mistake in the trade and deception of purchasers and to confusion as
7 to the origin, sponsorship or affiliation of DEFENDANT's goods. MOLDEX's
8 customers may erroneously conclude that MOLDEX sponsors or is responsible for
9 DEFENDANT's goods and those customers may have occasion to purchase
10 DEFENDANT's goods erroneously, believing that MOLDEX's standards of quality
11 and service apply to those goods, thereby doing great and irreparable harm to
12 MOLDEX's reputation.

13 19. The acts of DEFENDANT set out above constitute a false designation
14 of origin, sponsorship and chain of distribution of such goods and a false or
15 misleading description or representation of those goods.

16 20. By reason of the acts alleged herein, DEFENDANT's actions have
17 caused, and unless DEFENDANT is enjoined by this Court, its actions will continue
18 to cause irreparable harm and injury to MOLDEX's business, reputation and
19 goodwill. Accordingly, MOLDEX lacks an adequate remedy at law and it is
20 entitled to injunctive relief pursuant to 15 U.S.C. § 1116.

21 21. On information and belief, DEFENDANT's conduct described herein is
22 willful, wanton, malicious, oppressive and in conscious disregard of MOLDEX's
23 rights in its Green Color Mark, and MOLDEX is entitled to costs and reasonable
24 attorneys' fees.

25 **SECOND CLAIM FOR RELIEF**

26 **(Federal Trademark Dilution)**

27 22. MOLDEX realleges and incorporates herein by reference paragraphs 1
28 through 21 of this Complaint.

1 23. DEFENDANT makes, imports, distributes, uses, offers to sell and/or
2 sells in the United States, including this district, bright green earplugs that directly
3 infringe MOLDEX's Green Color Mark in violation of § 43(a) of the Lanham Act,
4 15 U.S.C. § 1125(c).

5 24. MOLDEX has extensively and continuously promoted and used its
6 earplug products with the Green Color Mark in the United States and it has become
7 a well-known, famous and distinctive indicator of the origin of MOLDEX's earplug
8 products.

9 25. DEFENDANT is making commercial use of a bright green mark and
10 trade dress that dilutes and is likely to dilute the distinctiveness of the MOLDEX's
11 Green Color Mark by eroding the public's exclusive identification of the Green
12 Color Mark with MOLDEX's earplug products and otherwise lessening the capacity
13 of MOLDEX's Green Color Mark to identify and distinguish its earplug products
14 and/or tarnishing and degrading the positive associations thereof.

15 26. By reason of DEFENDANT's acts alleged herein, MOLDEX has
16 suffered and will continue to suffer damage to its business, reputation and goodwill
17 and dilution of the distinctiveness and value of MOLDEX's Green Color Mark.
18 DEFENDANT's actions have caused, and unless DEFENDANT is enjoined by this
19 Court its actions will continue to cause irreparable harm and injury to MOLDEX.
20 Accordingly, MOLDEX is entitled to injunctive relief pursuant to 15 U.S.C. § 1116.

21 27. On information and belief, DEFENDANT's infringement of
22 MOLDEX's Green Color Mark has been and continues to be intentional, willful and
23 malicious with the intent to trade on the goodwill and reputation associated with
24 MOLDEX's Green Color Mark and/or to cause dilution of MOLDEX's Green Color
25 Mark, to the irreparable harm and injury of MOLDEX. MOLDEX therefore is
26 entitled to injunctive relief.

27 **THIRD CLAIM FOR RELIEF**

28 **(State Trademark Dilution)**

1 28. MOLDEX realleges and incorporates herein by reference paragraphs 1
2 through 27 of this Complaint.

3 29. MOLDEX has extensively and continuously promoted and used its
4 earplug products with the Green Color Mark in the United States and it has become
5 a well-known, famous and distinctive indicator of the origin of MOLDEX'S earplug
6 products.

7 30. DEFENDANT is making commercial use of a bright green mark and
8 trade dress that dilutes and is likely to dilute the distinctiveness of MOLDEX's
9 Green Color Mark by eroding the public's exclusive identification of the Green
10 Color Mark with MOLDEX's earplug products and otherwise lessening the capacity
11 of MOLDEX's Green Color Mark to identify and distinguish its earplug products
12 and/or tarnishing and degrading the positive associations thereof.

13 31. DEFENDANT is causing and will continue to cause irreparable injury
14 to MOLDEX's goodwill and business reputation, and dilution of the distinctiveness
15 and value of MOLDEX's Green Color Mark in violation of California's Model State
16 Trademark Act, CAL. BUS. & PROF. CODE § 14200 *et seq.*, as well as the anti-
17 dilution laws, whether codified by statute or developed by common law, of
18 Alabama, ALA. CODE § 8-12-17 (2002); Alaska, ALASKA STAT. § 45.50.180(d);
19 Arizona, ARIZ. REV. STAT. ANN. § 44-1448.01; Arkansas, A.C.A. §4-71-213;
20 Connecticut, Connecticut Unfair Trade Practices Act ("CUTPA"), CONN. GEN.
21 STAT., §§ 42-110a, *et seq.*; Delaware, 6 DEL. C. § 3313; Florida, FLA. STAT.
22 ANN § 495.151; Georgia, GA. CODE ANN. § 10-1-451; Hawaii, HRS § 482-32;
23 Idaho, I.C. § 48-513 (1996); Illinois, 765 ILC 1036/6l; Indiana, IND. CODE § 24-2-
24 1-13.5; Iowa, IOWA CODE ch. 548.113; Kansas, K.S.A. § 81-214; Louisiana, LA.
25 REV. STAT. ANN. 51:223.1; Maine, 10 M.R.S.A. § 1530; Massachusetts, MASS.
26 GEN. LAWS. ANN. ch. 110B, § 12; New Jersey, N.J. STAT. ANN. 56:3-13.20;
27 New York, N.Y. GEN. BUS. Law § 360-1; Pennsylvania, 54 PA. CONS. STAT.

28

1 ANN. § 1124; Texas, TEX. BUS. & COM. CODE ANN. § 16.29; and Washington,
2 WASH. REV. CODE ANN. § 19.77.160.

3 32. MOLDEX therefore is entitled to injunctive relief.

4 **FOURTH CLAIM FOR RELIEF**

5 **(Common Law Trademark Infringement and Unfair Competition)**

6 33. MOLDEX realleges and incorporates herein by reference paragraphs 1
7 through 32 of this Complaint.

8 34. DEFENDANT's acts alleged herein constitute unfair competition and
9 infringement of MOLDEX's common law rights in its Green Color Mark.

10 35. DEFENDANT has caused, and is causing, irreparable harm to
11 MOLDEX, and unless permanently restrained by this Court, said irreparable injury
12 will continue.

13 **FIFTH CLAIM FOR RELIEF**

14 **(State Unfair Competition)**

15 36. MOLDEX realleges and incorporates herein by reference paragraphs 1
16 through 35 of this Complaint.

17 37. MOLDEX is the exclusive owner of the common law trademark rights
18 in the Green Color Mark. No license or authorization has been granted to
19 DEFENDANT to use the Green Color Mark or any variations thereon.

20 38. MOLDEX is informed and believes and thereon alleges that
21 DEFENDANT, with full knowledge of the public awareness and value of
22 MOLDEX's Green Color Mark, has traded on the goodwill associated with the mark
23 and has misled and will continue to mislead the public into assuming a connection
24 between MOLDEX and DEFENDANT's products by continuing to use MOLDEX's
25 Green Color Mark for its products. This conduct has caused and will continue to
26 cause irreparable damage to MOLDEX's goodwill and reputation and unjustly
27 enrich DEFENDANT.
28

39. By falsely suggesting a connection with or sponsorship by MOLDEX, DEFENDANT's use of the Green Color Mark has caused and is likely to cause confusion or misunderstanding as to the source, sponsorship, or approval of DEFENDANT's goods by MOLDEX or as to DEFENDANT's affiliation, connection, or association with MOLDEX, and otherwise damage the public.

40. DEFENDANT's conduct constitutes unfair competition and deceptive acts or practices in the course of a business, trade, or commerce in violation of the laws of California, CAL. BUS. & PROF. CODE § 17200 *et seq.*; and Alabama, ALA. CODE §§ 8-10-1 *et seq.* (2002); Alaska, ALASKA STAT. 45.50.471 *et seq.*; Arizona, A.R.S. 44-1521 *et seq.*; Arkansas, A.C.A. § 4-75-201 *et seq.*; Colorado, COLO. REV. STAT §§ 66-2-101 *et seq.*; Connecticut, Connecticut Unfair Trade Practices Act ("CUTPA"), CONN. GEN. STAT., §§42-110a *et seq.*; Delaware, 6 DEL. C. §§ 2511 - 27; Florida, FLA. STAT. §§501.201 -213; Georgia, O.C.G.A. §§ 10-1-390 through 10-1-407; Hawaii, HRS § 480 *et seq.*; Idaho, I.C. §§ 48-601 *et seq.* (1979); Illinois, 815 ILL. COMP. STAT. ANN. 505/1 *et seq.*; Indiana, IND. CODE §§ 24-5-0.5-1 *et seq.*; Kansas, K.S.A. §§ 500-623 *et seq.*; Kentucky, K.R.S. ch. 365 *et seq.*; Louisiana, LA. REV. STAT. ANN. 51:1401 -1419; Maine, 5 M.R.S.A. §§ 206- 214; Maryland, MD. COM. LAW CODE ANN. §§ 13-301 *et seq.* (2005); Massachusetts, MASS. LAWS ANN. CH. 93A, §§1-11; Michigan, MICH. COMP. LAWS ANN. §§ 445.901 *et seq.*; Minnesota, MINN. STAT. ANN. §§ 325D.09 -325DD.16, 325F.68 - 325F.70; Nebraska, NEB. REV. STAT. §§ 59-1601 through 1623; Nevada, NEV. REV. STAT. §§ 598.0903 to 598.990, 598.A.010 to 280; New Hampshire, N.H. REV. STAT. ANN. § 358-A; New Jersey, N.J. STAT. ANN. §§ 56:4-1 to -2, 56:8-1 to -166; New Mexico, N.M. STAT. ANN. § 57-12-2; New York, N.Y. GEN. BUS. L. § 349; North Carolina, N.C. GEN. STAT. §75-1.1; North Dakota, N.D. CENT. CODE § 51-10; South Carolina, S.C. CODE ANN. §§ 39-5-10 through 39-5-560; South Dakota, S.D. CODIFIED LAWS § 37-24-6 ; Tennessee, TENN. CODE ANN. §§ 47-18-101, *et seq.*; Utah, UTAH CODE ANN. § 13-5—1, *et seq.*; Vermont, VT. STAT. ANN. TIT. 9, §§

2451 -2480n; Washington, WASH. REV. CODE § 19.86.010; Wisconsin, WIS. STAT. § 100.20; the Colorado Consumer Protection Act, COLO. REV. STAT. § 6-1-105, *et seq.*, and the unfair and deceptive trade practices statutes of other states, including Delaware, DEL. CODE ANN. TIT. 6, §§ 2531 -36; Georgia, GA. CODE ANN. §§ 10-1-370 to 10-1-375; Hawaii, HAW. REV. STAT. § 481 -A; Illinois, 815 ILL. COMP. ANN. 510/1 TO 510/7; Kentucky, KY. REV. STAT. ANN. §§ 367.10, 367.175; Maine, ME. REV. STAT. TIT. 10, §§ 1211-1216; Minnesota, MINN. STAT. ANN. §§ 325D.43 -325D.48; Nebraska, NEB. REV. STAT. §§ 87-301 – 87-306; Ohio, OHIO REV. CODE ANN. §§ 4165.01 to 4165.04; Oklahoma, OKLA. STAT. TIT. 78, § 75-1-1; and Rhode Island, R.I. GEN. LAWS §§ 6-13.1-1 through 6-13.1-19.

41. DEFENDANT has caused, and is causing, irreparable harm to MOLDEX, and unless permanently restrained by this Court, said irreparable injury will continue.

PRAYER FOR RELIEF

WHEREFORE, MOLDEX prays as follows:

42. For injunctive relief, as provided for in 15 U.S.C. §1116 , namely for permanent injunctive relief preventing DEFENDANT and its officers, agents, affiliates, servants, employees, and attorneys, and all those persons acting or attempting to act in concert or participation with it, from directly or indirectly:

a) manufacturing, advertising, promoting, marketing, importing or selling the Accused Earplug Products or any other product bearing any mark or trade dress confusingly similar to MOLDEX's Green Color Mark.

b) using any false designation of origin or false description, including the appearance of the Accused Earplug Products, that can, or is likely to, lead the consuming public, or individual members thereof, to believe that any goods produced, advertised, promoted, marketed, provided, imported or sold by DEFENDANT are in any manner associated or connected with MOLDEX, or are

1 advertised, promoted, imported, marketed, sold, licensed, sponsored, approved or
2 authorized by MOLDEX;

3 c) using any mark, trade dress, design, or source designation of any
4 kind on or in connection with DEFENDANT's earplug products that dilutes or is
5 likely to dilute the distinctiveness of MOLDEX's Green Color Mark; and

6 d) unfairly competing with MOLDEX in any manner whatsoever.

7 43. For an order, as provided for in 15 U.S.C. §1118, requiring that all
8 materials bearing and used to produce the infringing mark and trade dress be
9 delivered up and destroyed, and requiring DEFENDANT to withdraw from the
10 market all infringing products and advertising and promotional material displaying
11 the infringing products.

12 44. For an order directing DEFENDANT to file with the Court and serve
13 upon MOLDEX's counsel within thirty (30) days after entry of the order of
14 injunction, a report setting forth the manner and form in which DEFENDANT has
15 complied with the injunction, including the provision relating to destruction and
16 recall of infringing products and materials.

17 45. For MOLDEX's attorneys' fees and costs of this action as provided for
18 in 15 U.S.C. §1117.

19
20
21 DATED: March 16, 2012

QUINN EMANUEL URQUHART &
SULLIVAN LLP

22
23
24 By /s/ Joseph M. Paunovich

25 Harold A. Barza

26 Joseph M. Paunovich

27 Attorneys for Plaintiff

28 MOLDEX-METRIC, INC.

DEMAND FOR JURY TRIAL

Plaintiff MOLDEX hereby demands a trial by jury of all issues triable by jury.

DATED: March 16, 2012

QUINN EMANUEL URQUHART &
SULLIVAN LLP

By /s/ Joseph M. Paunovich

Harold A. Barza

Joseph M. Paunovich

Attorneys for Plaintiff

MOLDEX-METRIC, INC.

PROOF OF SERVICE

I am employed in the County of Los Angeles, State of California. I am over the age of eighteen years and not a party to the within action; my business address is 865 South Figueroa Street, 10th Floor, Los Angeles, California 90017-2543.

On March 16, 2012, I served true copies of the following document(s) described as,

(1) FEDERAL TRADEMARK INFRINGEMENT AND UNFAIR COMPETITION; (2) FEDERAL TRADEMARK DILUTION; (3) STATE TRADEMARK DILUTION; (4) COMMON LAW TRADEMARK INFRINGEMENT AND UNFAIR COMPETITION; (5) STATE UNFAIR COMPETITION DEMAND FOR JURY TRIAL on the interested parties in this action as follows:

Matthew A. Fischer
SEDGWICK LLP
333 Bush Street, 30th Floor
San Francisco, California 94104-2806

Heather L. McCloskey
Robert A. Helfing
SEDGWICK LLP
801 S. Figueroa Street 19th Floor
Los Angeles, California 90017-5556

BY FEDEX: I deposited such document(s) in a box or other facility regularly maintained by FedEx, or delivered such document(s) to a courier or driver authorized by FedEx to receive documents, in sealed envelope(s) or package(s) designated by FedEx with delivery fees paid or provided for, addressed to the person(s) being served.

I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct.

Executed on March 16, 2012, at Los Angeles, California.


Laura Valenzuela

quinn emanuel